

**REMARKS**

This Application has been carefully reviewed in light of the final Office Action mailed January 10, 2006 ("Office Action"). At the time of the Office Action, Claims 1-9, 11-20, 31, and 32 were pending in the Application. In the Office Action, the Examiner rejects Claims 1-9, 11-20, 31, and 32. Applicant amends Claim 11. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

**Response to Election/Restriction Requirement**

In the Office Action, the Examiner states that newly submitted Claims 21-30 are directed to an invention that is independent or distinct from the invention originally claimed. According to the Examiner, "[s]ince Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits." In response to the Office Action, Applicant hereby affirms the election of Group I (Claims 1-9, 11-20, and 31-32). This election is made without traverse. Applicant affirms the withdrawal of Claims 21-30 without prejudice or disclaimer.

**Section 101 Rejections and Interview Summary**

The Examiner rejects Claims 11-20 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner states that "[l]ogic must be stored in a computer readable storage medium, while the specification does not define the computer readable storage medium as a carrier wave (i.e. logic encoded in media can be a carrier wave)." On February 23, 2003, Applicant telephoned the Examiner to inquire as to this rejection. Applicant thanks the Examiner for conducting the telephone interview, and for the thoughtful consideration of this case. During the telephone interview, Applicant and Examiner discussed alternative claim language for reciting logic. As a result, Applicant has amended independent Claim 11 to recite "logic encoded in a storage medium." Applicant understands that the Examiner agrees that this language recites statutory subject matter within 35 U.S.C. § 101. For at least these

reasons, Applicant respectfully requests that Examiner's rejection of Claims 11-20 under 35 U.S.C. § 101 be withdrawn.

**Section 103 Rejections**

The Examiner rejects Claims 1-5, 7, 9, 11-15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,125,390 issued to Touboul ("*Touboul*"), U.S. Patent No. 5,748,098 issued to Grace ("*Grace*"), U.S. Patent No. 6,011,838 issued to Cox ("*Cox*"), U.S. Patent No. 5,440,688 issued to Nishida ("*Nishida*"), and U.S. Patent No. 5,933,601 issued to Fanshier et al. ("*Fanshier*"). Applicant traverses these rejections for the reasons stated below.

**A. The Claims are Allowable over the Proposed Combinations**

First, Applicant respectfully submits that each and every limitation of Applicant's claims is not disclosed, taught, or suggested by the proposed combinations. For example, independent Claim 1 of the present application recites:

A method for reporting the context of an alert condition, comprising:  
reporting an alert condition associated with a subject system object;  
identifying a relevant system object that is associated with the subject system object;  
analyzing the subject system object associated with the alert condition and the relevant system object to obtain context data;  
generating a context message based on the context data;  
and  
outputting the context message.

In the Office Action, the Examiner relies upon the *Touboul-Grace* combination to reject Applicant's Claim 1. Applicant respectfully submits, however, that the proposed *Touboul-Grace* combination does not disclose, teach, or suggest each and every element of Applicant's Claim 1.

For example, the proposed *Touboul-Grace* combination does not disclose, teach, or suggest “analyzing the subject system object associated with the alert condition and the relevant system object to obtain context data,” as recited in Applicant’s Claim 1. In the Office Action, the Examiner acknowledges that the recited features and operations are not disclosed in *Touboul*. Rather, the Examiner relies upon *Grace* for disclosure of Applicant’s step of analyzing. Applicant respectfully submits, however, that *Grace* does not cure the deficiencies of *Touboul*. According to *Grace*, “[i]t is well established that effects of a network failure, such as the failure of a high bit rate line system, will propagate down through a hierarchy of dependent resources and initiate many nearly simultaneous alarm messages. Time and other resources can be wasted by investigating the sources of all the alarms if the underlying cause has not been identified.” (Column 1, lines 39-44). Accordingly, *Grace* proposes “a method for automatically processing alarms signals in a network management system” that includes “storing historical data concerning the times at which alarms conditions occur in the telecommunications network . . . [and] correlating the identified alarm conditions by analysing the historical data to determine the statistical probabilities of pairs of the identified alarm conditions occurring by chance within the same temporal window.” (Column 2, line 51 through Column 3, line 4). As a result, “a probable relationship between alarm conditions can be identified . . . without prior knowledge of any relationship between components of the network.” (Column 3, lines 5-10). With regard to the analysis of the alarm conditions, *Grace* discloses that “analysis may be done in real time, during the fault condition, in order to locate and repair the cause of the failure, which may result in the clearance of the other fault reports without a technician’s attendance being required.” (Column 3, lines 54-58). Thus, *Grace* merely discloses using an empirical analysis to determine the relationship of components as evidence by simultaneous fault alarms such that the alarms of the dependent components may be ignored. As such, *Grace* actually teaches away from “analyzing the subject system object associated with the alert condition and the relevant system object to obtain context data,” as recited in Applicant’s Claim 1.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1.

The Examiner also relies on the *Touboul-Grace* combination to reject independent Claims 9 and 11. Applicant respectfully submits, however, that the *Touboul-Grace* combination does not disclose, teach, or suggest each and every element of Applicant's independent Claim 9. For example, Claim 9 recites "means for analyzing the subject system object associated with the alert condition and the relevant system object to obtain context data." As another example, Claim 11 recites "logic encoded in media and operable when executed to . . . analyze the subject system object associated with the alert condition and the relevant system object to obtain context data." Thus, for reasons analogous to those discussed above with regard to Claim 1, Applicant respectfully submits that the *Touboul-Grace* combination does not disclose, teach, or suggest each and every element set forth in Applicant's independent Claims 9 and 11.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 9 and 11.

The Examiner rejects Claims 6 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Touboul* and *Grace* in view of *Cox*. The Examiner rejects Claims 8 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Touboul* and *Grace* in view of *Nishida*. The Examiner rejects Claims 19-20 and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over *Touboul* and *Grace* in view of U.S. Patent No. 5,933,601 issued to Fanshier et al. ("*Fanshier*").

Dependent Claims 2-8 and 31-32 depend on Claim 1, which Applicant has shown above to be allowable. Dependent Claims 12-20 depend on Claim 11, which Applicant has shown above to be allowable. Additionally, Claims 2-8, 12-20, and 31-32 are patentable because they recite additional features and operations not disclosed, taught, or suggested in the prior art. Since Claims 2-8, 12-20, and 31-32 incorporate the limitations

of their respective independent claims, Applicant has not provided detailed arguments with respect to Claims 2-8, 12-20, and 31-32. However, Applicant remains ready to do so if it becomes appropriate. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 2-8, 12-20, and 31-32.

### **B. The Proposed Combinations are Improper**

Second, Applicant respectfully submits that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to make the proposed combinations of references. Applicant's claims are allowable for at least this additional reason.

#### **1. The Legal Standard**

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The governing Federal Circuit case law makes this strict legal standard clear.<sup>1</sup> According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion,

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<sup>1</sup> Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* ***Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, ***“The tendency to resort to 'hindsight' based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.”*** M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this

methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is ***rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.*** Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

## 2. The Touboul-Grace Combination

According to the Examiner and with regard to independent Claims 1, 9, and 11, “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Touboul* and *Grace* because *Grace*’s teaching of identifying a relevant system object would increase efficiency of *Touboul*’s system by avoiding time wasted on investigating the sources of all the alert condition associated with dependent resources (col. 1, lines 40-50).” (Office Action, page 4). It appears that the Examiner has merely proposed an alleged advantage of combining *Touboul* with *Grace* (advantages which Applicant does not admit could even be achieved by combining these

references in the manner the Examiner proposes). While the Examiner has cited a portion of *Grace* that tout an advantage of its event correlation system, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the network monitoring and controlling system disclosed in *Touboul* with the event correlation techniques disclosed in *Grace*. In other words, the alleged advantage of the system disclosed in *Grace* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Touboul* with the cited disclosure in *Grace*; (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicant's claims. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Furthermore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular techniques disclosed in *Touboul* with the event correlation techniques of *Grace* to reach Applicant's claims in the manner proposed by the Examiner.<sup>2</sup> Applicant respectfully submits that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicant's claims as a blueprint, in an attempt to reconstruct Applicant's claims. It is clear based at least on the many distinctions between the references that the proposed *Touboul-Grace* combination does

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<sup>2</sup> If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

not, taken as a whole, suggest the claimed invention, taken as a whole. As described above, *Grace* relates to identifying “a probable relationship between alarm conditions” such that “analysis may be done in real time, during the fault condition, in order to locate and repair the cause of the failure, which may result in the clearance of the other fault reports without a technician’s attendance being required.” (Column 3, lines 5-10 and 54-58). Thus, *Grace* merely discloses using an empirical analysis to determine the relationship of components as evidence by simultaneous fault alarms such that the alarms of the dependent components may be ignored. Indeed, since *Grace* teaches away from Applicant’s claimed invention, Applicant finds no reason in either *Richmond* or *O’Brien* as to why one of ordinary skill in the art would be motivated to combine these two seemingly unrelated references in the manner proposed by the Examiner in an effort to meet Applicant’s claim limitations.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Touboul* with *Grace* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner’s conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 1-9, 11-20, and 31-32.

### **3. The *Touboul-Grace-Cox* Combination**

According to the Examiner and with regard to independent Claims 6 and 16, “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Touboul*, *Grace*, and *Cox* because *Cox*’s teaching of determining a traffic load would increase the efficiency of *Touboul*’s and *Grace*’s systems by minimizing the amount of failure caused by overloading a system object (col. 1, lines 11-15).” (Office Action, page 6). Again, it appears that the Examiner has merely

proposed an alleged advantage of combining *Touboul* and *Grace* with *Cox* (advantages which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portion of *Cox* that tout an advantage of its techniques for determining a traffic load, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the network monitoring and controlling system disclosed in *Touboul* with the event correlation techniques disclosed in *Grace* and the traffic load determination techniques disclosed in *Cox*. In other words, the alleged advantage of the system disclosed in *Cox* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Touboul* and *Grace* with the disclosure of *Cox*; (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicant's claims. Applicant respectfully submits that if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Furthermore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular techniques disclosed in *Touboul* and *Grace* with the traffic determination techniques of *Cox* in the manner proposed by the Examiner.<sup>3</sup> As described in the previous Response to Office Action submitted on October 6, 2005, *Touboul* relates to "a method

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<sup>3</sup> If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

and apparatus which automatically detects and corrects error conditions occurring in programs running on network workstations.” (Column 1, lines 12-15). Specifically, the system of *Touboul* identifies the error-causing application and applies a corrective measure to address the identified problem. In contrast, *Cox* relates to a system that “dynamically and automatically determines the correct peak hour and average usage at that hour (or other time period) for selected components of network elements like a switch.” (Column 3, lines 30-33). As a result, “the load on the selected component may be adjusted or the network otherwise reconfigured.” (Column 3, lines 46-47). In addition to being outside the field of technology of *Touboul*, the traffic load determination system of *Cox* does not deal with the same types of problems encountered by fault-detection systems such as *Touboul*. For example, *Cox* explicitly states that the objective of the disclosed packet telephony system is to provide “more accurate usage data . . . [to allow] traffic engineers to take proactive measures to prevent new conditions from impacting service.” (Column 3, lines 56-59). Thus, the solution proposed by *Cox* is designed to prevent system failures. As a result, one of ordinary skill in the art would not have been motivated to combine the traffic determination techniques of *Cox* with the system of *Touboul*, which is designed to detect, report and correct program errors (Column 4, lines 6-7). In this respect, Applicant respectfully submits that the references are non-analogous art and, because not related, an improper combination.

The identified differences in *Touboul* and *Cox* provide evidence that one of ordinary skill in the art at the time of Applicant’s invention would have considered the references as relating to different fields of invention and would not have made the proposed combination. Applicant respectfully submits that the Examiner’s attempt to modify or combine *Touboul* with *Grace* and *Cox* appears to constitute the type of impermissible hindsight reconstruction of Applicant’s claims, using Applicant’s claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases. Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Touboul* with *Grace* and *Cox* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner’s conclusions set forth in the Office

Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 6 and 16.

**CONCLUSION**

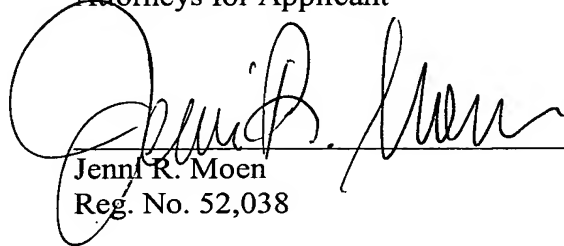
Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicant



Jenni R. Moen  
Reg. No. 52,038

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Correspondence Address:

at Customer No. **05073**